Gp/1752

PATENT
30205/37328

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Min Ho Jung et al.

Serial No.: 09/878,803

Filed: June 11, 2001

For: Additive for Photoresist Composition for Resist Flow Process

Group Art Unit: 1752

Examiner: Yvette C. Thornton

I hereby certify that this paper and the documents referred to as enclosed therewith are being deposited with the United States Postal Service as first class mail, postage prepaid, on **March 5, 2003**, in an envelope addressed to Commissioner for Patents, Washington, D.C. 20231.

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RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the restriction requirement imposed in the office action mailed on February 6, 2003, applicants provisionally elect Group I, claims 1-3 and 5-12, *with traverse*.

The office action has identified pending claims 1-20 as being directed to three distinct inventions. Specifically, the office action has required an election between claims 1-3 and 5-12 (Group I), claims 4 and 13-16 (Group II) and claims 17-20 (Group III). As set forth in detail below, without denying that the claims are patentably distinct, applicants traverse this restriction requirement. Subject to that traversal and in accordance with requirements of 37 C.F.R. § 1.143, applicants have provisionally elected claims 1-3 and 5-12 (Group I) for further prosecution in this application. Reconsideration and withdrawal of the restriction requirement is, however, requested in view of the following remarks.

In making the restriction between Groups I and II, the Patent Office, as required by M.P.E.P § 806.05(h), states that the photoresist composition of Group I could be used in a materially different process than the process of forming a photoresist pattern of Group II. The examples set forth in the office action include

"coating on a substrate which does not require light irradiation; in a process of drying a cast polymeric film; or in the manufacture of antireflective films." Applicants respectfully submit that these examples are unrealistic. Group I is directed toward a photoresist composition. Applicants are unaware of any photoresist composition which is not used as such or which is used to coat a substrate and which is not later irradiated. Further, applicants are unaware of any drying process which would use a photoresist composition or any process for the manufacture of antireflective films which would use a photoresist composition. The processes of Group II and the compositions of Group I are directly related either by claim dependency (claim 4) or by claiming the same photoresist formula (claims 13-16). Any search conducted by the examiner would necessarily cover Groups I and II.

The Patent Office bases its restriction between Groups I and III on M.P.E.P. § 806.04(b), third paragraph and § 806.04(h). Again, the Patent Office relies upon the hypothetical situation where the photoresist composition of Group I could be deemed as a useful coating on a substrate which does not require light irradiation. Again, applicants consider this hypothetical unrealistic. The semiconductor elements of claims 17-20 require the photoresist compositions of claim 1 and therefore any search regarding the subject matter of Group III would necessarily cover the subject matter of Group I.

In summary, the Patent Office has not disclosed a practical and realistic example in support of its restriction requirement. Further, the Patent Office has not showed any utility for its hypothetical example.

If there is a serious burden in the present application, it is on the assignee of this application as result of this restriction requirement. Unless the restriction requirement is withdrawn, the assignee must not only prosecute as many as three separate applications, which multiplies the cost and time of obtaining protection for the inventive subject matter, but it must also then pay separate maintenance fees and issue fees for the issued patents. It is respectfully submitted that the burden of the additional expense incurred in order to obtain three different patents and the further expense in maintaining those patents suffered by the taxpayer, far outweigh any possible burden the Patent Office may incur as a result of simultaneously examining the claims of this application.

Further, the Patent Office fails to address the second required criteria for a restriction as set forth in the M.P.E.P. § 803. Specifically, § 803 states:

> If the search and examination of an entire application can be made without serious burden, the examiner <u>must</u> examine it on the merits, <u>even though it includes claims to distinct or independent inventions</u>. (Emphasis Added).

Therefore, applicants respectfully request that the restriction requirement be withdrawn.

An early action on the merits of claims 1-20 is respectfully requested.

The Commissioner is authorized to charge any fee deficiency required by this paper, or credit any overpayment, to Deposit Account No. 13-2855.

Respectfully submitted,

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March 5, 2003 By: ______________________

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